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JACK FRIEDMAN SCHMEISER, OLSEN & WATTS 3 LEAR JET LANE SUITE 201 LATHAM, NJ 12110			REAGAN, JAMES A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/810,629
Filing Date: March 16, 2001
Appellant(s): CURTIS ET AL.

Jack P. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 August 2005 appealing from the Office action mailed 10 March 2005, as well as the ORDER by the BPAI filed on 31 January 2006. The previous Examiner's answer is hereby VACATED.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,199,099 B1

Gershman et al.

03-2001

Brockman et al, US Patent Publication US 2002/0123919 A1, Pub. Sep. 5, 2002; Appl. No 10/035,844,

Effective date: Mar. 2, 2001.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman and further in view of Brockman et. al., (US 2002/0123919 A1).

Claims 1, 4, 7, 11, 15, 19, 23, and 27:

Gershman discloses a method for characterizing a service provider (Abstract, Fig 1A, 16, associated text; C34, L8-42), essentially disclosing:

- gathering information on characteristics of a service provider;
- analyzing the information to provide an outcome;
- generating a report responsive to the outcome; and
- providing the report to at least two clients of the service provider;
- wherein the acts of analyzing, generating, and providing are performed by a
- management service.

Gershman does not specifically disclose that the service providers are ASPS and/or ISPS. However, Gershman does teach that all types of vendors/suppliers/service providers may be targets for analysis reports (Fig 1A). Moreover, Brockman discloses a management service method and system that targets a telecommunications service provider (Abstract; Summary of the Invention). ASPS and ISPS are vendors playing major roles in business applications and telecommunications. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have adapted Gershman's system to many different types of providers, including telecommunications vendors such as ISPS, as taught by Brockman, and/or to

ASPS, because the system can easily be adapted to any type of provider, and as such, would increase the revenue stream for the management service. In addition, Gershman teaches that "availability" of products/services is a significant characteristic for customers to learn about and make decisions on (Summary of the Invention; Fig 10A, associated text; C2, L65). Brockman, erstwhile, discloses that "performance" is yet another yardstick by which clients should measure their intended or current vendors (Par. 17, 66-67, 106-109). Other significant characteristics such as price, customer service, and others may be used in the analyses and reports, as taught by both references. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included "performance", "availability", and "security" the main characteristics to analyze and report on, in the case of ASPS and ISPS, because those are by far the most important features distinguishing one vendor from another in this field.

Claim 4:

Gershman discloses all the limitations of claim 1. Neither Gershman nor Brockman specifically disclose the act of providing comprises the act of selling the report. Gershman's system however, is directed toward consumers and Brockman's to businesses. Therefore, it's obvious that both systems are designed to offer services for payment from their target audiences. It would have been obvious to one ordinarily skilled in the art at the time the invention was made that management reports such as those contemplated by both references would not be offered free of charge.

Claims 5 and 6:

Gershman discloses all the limitations of claim 1. Gershman further teaches that his reports will be available to clients online (Fig 16, associated text) as well as in hard copy (C46, L64).

Claims 8, 12, 16, 20, 24, and 28:

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Using the same analysis as for claim 4 above, Gershman and Brockman further disclose: the act of providing composes the act of selling the report.

Claims 9, 13, 17, 21, 25 and 29:

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Gershman further discloses the report comprises hard copy (see claim 5 above).

Claims 10, 14, 18, 22, 26, and 30:

Gershman in view of Brockman discloses all the limitations of claims 7, 11, 15, 19, 23, and 27, respectively. Gershman further discloses: the report comprises soft copy (see claim 6 above).

Claims 31-42:

The combination of Gershman/Brockman discloses the limitations as shown above. Gershman/Brockman do not expressly show:

- the information on the performance of the application service provider includes information about responsiveness of the application service provider;
- the information about the responsiveness of the application service provider is characterized statistically by a mean value and a probability density function or cumulative distribution function that describe a time between receipt by the application service provider of an incoming request to the application service provider and an outgoing response from the application service provider;
- the information on security concerns a vulnerability of the service provider to attacks by unauthorized parties seeking to steal information from the service provider or to vandalize the service provider;
- the information on security is characterized statistically by a count or other measure of said attacks that result in adverse consequences to the serviced provider or in adverse consequences to one or more clients or in adverse consequences to a member of a user population over a given period of time;
- the information on availability of the application service provider concerns a susceptibility of the service provider to failure;

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- said feature is measured by minutes-of-time-per-month when the service provider is unable to respond within a predetermined interval to an incoming request from a client or from a member of a user population;

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The information collection and storage steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from a service provider any type of security information, performance information, and statistical analysis thereof, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

(10) Response to Argument

Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. Specifically, Appellant states *Gershman...does not disclose that the user requesting the report is a client of the service provider*. The Examiner disagrees. Gershman discloses a method for characterizing a service provider (Abstract, Fig 1A, 16, associated text; C34, L8-42). Gershman does not specifically disclose that the service providers are ASPs and/or ISPs. However, Gershman does teach that all types of vendors/suppliers/service providers may be targets for analysis reports (Fig 1A). Gershman also teaches, "The Supplier Profile Database 1050 contains information about the product and service providers integrated into the intention. The information contained in this database provides a link between the intention framework and the suppliers. It includes product lists, features and descriptions, and addresses of the suppliers' product web sites. The Customer

Profile Database 1060 contains personal information about the customers, such as name, address, social security number and credit card information, personal preferences, behavioral information, history, and web site layout preferences. The Supplier's Web Server 1070 provides access to all of the supplier's databases necessary to provide information and transactional support to the customer (emphasis added)." Clearly, Gershman anticipates clients or customers requesting information about a product or service. In addition, Brockman discloses a management service method and system that targets a telecommunications service provider (Abstract; Summary of the invention), as well as obtaining telecommunications data from telecommunications vendors (ISP's and ASP's) for aggregation and analysis (see at least paragraph 0010).

Appellant states *Gershman does not disclose that the report is provided to at least two clients of the service provider*. As shown in the preceding paragraph, Gershman teaches, "The Supplier's Web Server 1070 provides access to all of the supplier's databases necessary to provide information and transactional support to the customer (emphasis added)." Gershman's use of the Internet and networked computing environment innately discloses multiple customers.

Appellant states that *Gershman...does not disclose that the report is responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability*. The Examiner respectfully disagrees and points to Gershman who discloses a report generating function (Figure 16), a database containing information on a product and service providers (ASP's and ISP's), features and descriptions (characteristics), availability and pricing (see column 31, lines 6-20). Gershman also discloses a Thin client hardware application, which clearly illustrates what functions are considered relevant and vital to a network providers functionality i.e. security, performance, and availability. See column 57, lines 12-55. By incorporating these elements into Gershman's own system, Gershman testifies to the inherent necessity of reporting these elements to customers of an Internet/Application Service Provider. Brockman, erstwhile, discloses that "performance" is yet another yardstick by which clients should measure their intended or current vendors (Par. 17, 66-

67, 106-109). Other significant characteristics such as price, customer service, and others may be used in the analyses and reports, as taught by both references. Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have included "performance", "availability", and "security" the main characteristics to analyze and report on, in the case of ASPS and ISPS, because those are by far the most important features distinguishing one vendor from another in this field.

In the above arguments, it appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). Taken together, the combination of Gershman/Brockman fully discloses the Appellant's invention.

Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. Specifically, Appellant states *Gershman...does not disclose gathering information about a service provider's characteristics, performance, security, and availability*. The Examiner disagrees and points to the paragraphs above. The combination of Gershman/Brockman discloses a report responsive to the outcome derived from analyzing the information on the service provider's characteristics, performance, security, and availability, and therefore inherently discloses the gathering of facts in support of these metrics.

Appellants respectfully contend that claims 1, 7, 11, 15, 19, 23, and 25 are not unpatentable over Gershman in view of Brockman, because Gershman in view of Brockman does not teach or suggest each and every feature of claims 1, 7, 11, 15, 19, 23, and 25. Specifically, Appellant states *Gershman...does not disclose analyzing, to provide an outcome, about a service provider's characteristics, performance, security, and availability*. The Examiner disagrees and points to the paragraphs above. The combination of Gershman/Brockman discloses a report responsive to the outcome derived from analyzing the information on the service provider's

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characteristics, performance, security, and availability, and therefore inherently discloses the producing an end result or summary in support of these metrics.

With regard to any suggestion that there is no motivation to combine the applied references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

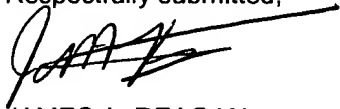
According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, Gershman discloses generating product information and providing access to rating and reports of products and services carried out by a computer networked system i.e. the Internet. Brockman discloses aggregation and analysis of customer oriented telecommunications data i.e. ASP's and ISP's and providing that data to interested parties. Gershman states, "The present invention relates to agent based systems and more particularly to a mobile computing environment that accesses the Internet to obtain product information for a user utilizing a distributed communication network." Brockman discloses determining whether or not business resources are being properly utilized (see at least paragraph 004). ASPs and ISPs are vendors playing major roles in business applications and telecommunications. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to have adapted Gershman's system to many different types of providers, including telecommunications vendors such as ISP's, as taught by Brockman, and/or to ASP's, because the system can easily be adapted to any type of provider, and as such, would increase the revenue stream for the management service. As such, it is seen that the Examiner's combination of references is supported by the applied prior art of record. Ergo it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JAMES A. REAGAN

Primary Examiner

Art Unit 3621

06 February 2006

Conferees:

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